

REMARKS

Prior to initiation of prosecution, applicants are amending various claims, canceling one claim and adding new claims. Claims 1, 18 and 19 are being amended to further define the chromosomal fragments as containing the "exogenous nucleic acid" recited in paragraph (a). They are also being amended to further define the exogenous nucleic acid in terms of exhibiting normal plant chromosomal "activities". This term has been introduced into claims 20 and 29 as well. This recitation is contained in the specification e.g., page 8, lines 3-7. Claim 15 is being amended by deleting the recitation "encoding" and by replacing it with the recitation "comprising". A yeast chromosomal element is a nucleic acid sequence. Claim 30 has been amended to further define the recombinant nucleic acid as one that "exhibits normal plant chromosomal activities." New claim 36 is dependent on claim 15 and further defines the yeast chromosomal element as comprising a first centromeric sequence functional in a yeast cell. New claim 37 is dependent on claim 36 and further defines the chromosomal fragments as further comprising a second centromeric sequence functional in a plant cell. This language is contained in the specification, e.g., page 3, lines 14-24, and pages 10-11. New claims 38-41 are also directed to a method of making a plant artificial chromosome. Claims 1 and 38 are similar; in paragraph (a) of claim 38, however, the exogenous nucleic acid is further defined as comprising a "selectable marker gene." This language is contained in the specification, e.g., pages 5-6. In view of the addition of claim 38, claim 17 is being cancelled. As in the case of claim 36 and 37, the recitations of claims 39-41 are also disclosed in the specification, e.g., page 3 and 10-11. Claim 42 is directed to a recombinant nucleic acid that differs from claim 30 in terms of being dependent upon claims 37 and 41.

Thus, no new matter has been added. Accordingly, entry of the amendments is respectfully requested.

In response to the requirement for restriction, applicants hereby elect Group I, directed to claims 1-16, 18 and 20-28. Applicants respectfully traverse the requirement, and request examination of claims 1-16 and 18-42 on the merits.

With respect to a group of inventions claimed in an international application, unity of invention exists when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. Such features are defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. Whether or not any particular technical feature makes a contribution over the prior art, and therefore constitutes a special technical feature, should be considered with respect to novelty and inventive step. See, MPEP §1850 ("DETERMINATION OF UNITY OF INVENTION").

Preliminary international examination (by the same examiner) concluded with a determination on the record that claims 1-35 possessed novelty and inventive step over the prior art. In addition, the claims (and particularly claims 1-29 and 36-42) possess a common inventive concept. Claims 19 and 29 embody the same inventive concept as the claims of Group I, a difference being that the methodology involves intermingling of the genetic material of the first and second plant species at the level of a whole plant (e.g., "crossing" the first and second plant species). Therefore, the proper conclusion is that the claims possess unity of invention because they share a special technical feature. See MPEP §1850 ("If, on the other hand, there is a single general inventive concept that appears

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novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise.")

Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection, or modification of the requirement by joining Group II (claims 19 and 29), and new claims 36-42 with Group I.

In the event any fee is due in connection with the present response, the Examiner is authorized to charge Applicant's Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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